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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,986	07/24/2002	Frank Hofmann	HOFM3001/JEK	7030

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EXAMINER
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DURAND, PAUL R

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 02/24/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/069,986

Applicant(s)

HOFMANN ET AL.

Examiner

Paul Durand

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9, 12-14 and 17 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 11, 15, 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 recites the limitation "packet" in line 4. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Pennini et al (US 5,996,314).

Pennini discloses the invention as claimed including a transport apparatus comprised of belts 23 and 25, stacker wheels 47 and 49, strapping units 51 and 53 and deposit device in the form of platform 111 and bins 17 and 19 (see abstract, Figs.1, 2,6,17 and C3, L16-32).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-4,9,12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pennini et al in view of Zipf (US 2,923,587).

In regard to claim 2, Pennini discloses the invention substantially as claimed including a deposit device comprised of bins 17 and 19. What Pennini does not disclose is the use of a movable plate platform. However, Zipf teaches that it is old and well known in the art to provide a storage bin 52 that includes a plate 50 that guides the sheet material and is positioned above the bin 52 when the bin is in an operating mode and is positioned away from the bin when the bin is in a second non operating mode for the purpose of efficiently stacking material (see Fig. 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Pennini with the storage means as taught by Zipf for the purpose of efficiently stacking material.

In regard to claim 3, Pennini and Zipf disclose the invention substantially as claimed except for a strapping unit swivel mounted on a door. It would have been an obvious matter of design choice to mount a strapping unit on a door, since applicant has not disclosed that the specific mounting location solves any stated problem or is for any

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particular purpose and it appears the invention would do equally well with the strapping unit mounted inside the machine.

In regard to claim 4, Pennini discloses the invention substantially as claimed including multiple stacking and strapping stations 51 and 53 with associated discharge bins 17 and 19 that operate in tandem (see fig. 2).

In regard to claim 9, Pennini discloses the invention substantially as claimed except for the use of removable storage bins. However, Zipf teaches that it is old and well known in the art to provide a storage bin 52, that is arranged to be removable and arranged in a safe manner inside a reinforced machine for the purpose of efficiently removing a stacked set of documents and maintaining the machine in a continuously operative condition (see Fig. 2, and C4, L3-10). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Pennini with the storage means as taught by Zipf for the purpose of maintaining the machine in a continuously operative condition.

In regard to claims 12 and 13, Pennini discloses the invention substantially as claimed including a gripper in the form of stacker wheels 47 and 49, which transport the sheet to the strapping unit 51 and 53. Furthermore discloses the invention substantially as claimed including printing means 163, which prints information on the strap with data for the purpose of increasing strapping, and printing efficiency (see Fig. 2,7, and C7, L12-28).

7. Claims 5-8 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pennini et al in view of Zipf and in further view of Tsuji (US 4,369,360).

Pennini discloses the invention substantially as claimed including the use of storage bins 17 and 19. Furthermore, Zipf teaches that it is old and well known in the art to provide a storage bin 52 that includes a plate 50 that guides the sheet material and the use of micro switches 113 and 115 that index the stack of sheets downward as more sheets are added (see C4, L49-64). What Pennini and Zipf do not disclose is the use of sensors to perform this function. However, Tsuji teaches that it is old and well known in the art of stacking to provide sensors 32A and 32B control circuit 42 to control the height of the storage in response to added sheets for the purpose of preventing the overflow of sheet material (see Fig. 2 and C4, L5-64). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Pennini and Zipf with the sensors as taught by Tsuji for the purpose of preventing the overflow of sheet material.

Furthermore, in regard to claims 7 and 8, Pennini teaches that it is old and well known to provide a stacking apparatus with a strapping unit.

#### ***Allowable Subject Matter***

8. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claims 11 and 15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

10. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.


***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 703-305-4962. The examiner can normally be reached on 0730-1800, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 703-308-2187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Durand  
February 17, 2004



Rinaldi I. Rada  
Supervisory Patent Examiner  
Group 3700